

REMARKS

The Applicants wish to thank the Examiner for the courtesy of an interview on October 8, 2003.

Claims 1-37 and 39-77 are pending in this application. Claims 1-36, 40, 42, 44-46, 50-57, 59, 64, and 65 have been withdrawn by the Examiner. Claims 37, 39, 41, 43, 47-49, 58, 60-63, and 66-77 have been examined. Claims 37, 39, 41, 49, 71, and 73 have been amended. Claims 38 and 58 have been canceled.

Independent claims 37, 71, and 73 have been amended to add the provisos "that the at least one compound comprising at least one C₅ to C₇ saccharide unit is not glucosamine, and that when the at least one compound comprising at least one C₅ to C₇ saccharide unit is chosen from polysaccharides, then the at least one amino group is unsubstituted." Support for these amendments can be found in the specification at p. 18, lines 4-15, which lists non-limiting examples of the at least one compound including monosaccharides, polymers comprising at least one monosaccharide (such as polysaccharides), and oligosaccharides. Specific examples are listed in p. 18, line 17 to p. 19, line 7. Moreover, p. 17, lines 17-18 indicate that the at least one amino group may be chosen from substituted and unsubstituted amino groups.

Applicants respectfully submit that *In re Johnson*, 558 F.2d 1008 (C.C.P.A. 1977) provides legal precedent for this proviso. *Johnson* provides that a "broad and complete generic disclosure, coupled with extensive examples fully supportive of the limited genus now claimed" supports the exclusion of specific compounds also disclosed. *In re Johnson* 558 F.2d at 1018. In *Johnson*, a broad class of precursor compounds was recited including 26 specific examples. An added proviso excluded certain compounds

to provide a limited genus, where 14 examples fell within the scope of the limited genus. The court in *Johnson* held that the written description supported the broader genus, and "having described the whole, necessarily described the part remaining." *Id.* at 1019.

In the present specification, a class of compounds comprising at least one C₅ to C₇ saccharide unit was disclosed. Additionally, numerous examples of these compounds were set forth in the specification, which are representative of the entire range of compounds set forth in the claims. The specification and claims as originally filed set forth the specific compounds that are excluded by the added provisos. As in *Johnson*, this fact provides sufficient evidence that Applicants considered the subject matter of the presently claimed invention to be within the scope of their invention, and the added provisos are not new matter.

In light of the added provisos, claims 39 and 41, which depend from claim 37, have been amended to limit the at least one compound to those chosen from monosaccharides and oligosaccharides. Claim 49 has been amended to delete "glucosamine."

New claim 78 has been added. Claim 78 is directed to a composition "comprising at least one glucosamine and at least one compound other than glucosamine comprising at least one C₅ to C₇ saccharide unit substituted with at least one amino group, wherein said at least one compound is chosen from monosaccharides and oligosaccharides." Support for claim 78 can be found in the specification at p. 18, line 22, listing glucosamine, and at p. 19, line 18 to p. 20, line 2, which lists non-limiting examples of additional sugars including monosaccharides and oligosaccharides.

BEST AVAILABLE COPY

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

BEST AVAILABLE COPY

New claim 79 has been added. Claim 79 is directed to a composition comprising at least one compound comprising at least one C₅ to C₇ saccharide unit substituted with at least one amino group, wherein said at least one compound is chosen from polysaccharides, and at least one additional sugar, said at least one additional sugar being different from said at least one compound and wherein said at least one additional sugar is unsubstituted. Support for claim 79 can be found in the specification at p. 18, lines 4-10, which lists non-limiting examples of the at least one compound including polymers comprising at least one monosaccharide (such as polysaccharides). The specification at p. 19, line 18 to p. 20, line 5, which lists non-limiting examples of additional sugars. Moreover, p. 20, line 5 provides written description for the at least one additional sugar being unsubstituted.

No new matter has been added by these amendments. Accordingly, Applicants now await an action on the merits.

If there is any fee due in connection with the filing of this Preliminary Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: Maria T. Bautista
Maria T. Bautista
Reg. No. 52,516

Dated: February 9, 2004

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com